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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DENNISON, JERRY B

ART UNIT PAPER NUMBER

2143

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/602,024	JACOBS ET AL.	
	Examiner	Art Unit	
	J. Bret Dennison	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to Application Number 09/602,024 received on 21 September 2005.
2. Claims 18-35 are presented for examination.
3. It is noted that a new Examiner has been assigned to this case. Any future correspondence regarding this case should be directed to the Examiner listed below
4. The amendment filed is insufficient to overcome the Claim Rejections – 35 USC 102 and 103. The changes made to claim 18 have not changed the scope of the claim. The rejections for claims 18-30 are maintained and cited as stated below.
5. The text of those sections of Title 35, U.S. Code 102 and 103 not included in this action can be found in a prior Office action.

Claim Objections

6. Claims 18 and 32 are objected to because of the following informalities:
Claims 18 and 32 are in improper format as the claims have multiple interpretations due to grammatical errors and lack of indentations. Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i). There may be plural indentations to further segregate subcombinations or related steps. See MPEP 608.01(m). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 34 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 34 and 35 include that the domain contains sub-domains. Examiner was unable to find anything including sub-domains in the instant specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18, 20, 28, and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Regarding claims 18 and 32, Examiner is unclear whether the system comprises both a service manager and components of a distributed electronic system OR the system comprises a service manager, the service manager interacting with both the

information repository and components of a distributed system. Such problems with claim language occur due to improper format of the claims.

8. Claim 28 recites the limitation "one of more of a plurality of object request brokers". It is unclear to Examiner what this limitation means.

9. Claim 20 recites the limitation "which interface interacts..." There is insufficient antecedent basis for this limitation in the claim. Examiner suggests changing the limitation to "in which the user interface interacts..."

10. Claim 32 recites the phrase "and/or", which renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 18-20, 22-25 and 27-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Schultz et al (U.S. 6,453,339).

12. Regarding claims 18-20, 22-25, and 27-30, Schultz was applied for the claim rejections, cited in a previous Office Action, and still remain applicable to these claims.

13. Regarding claim 31, Schultz disclosed the limitations, substantially as claimed, as described in claim 18, including wherein the service manager enables activation of services (Schultz, col. 3, lines 45-55, Schultz disclosed an automated process that alerts the user when an event pertinent to that user has occurred, thereby activating an the communication to the user in the form of an alert).

14. Regarding claim 31, Schultz disclosed an automated provisioning system adapted to use an LDAP or X.500 compatible directory enabled information repository, the system comprising a service manager adapted to interact with the information repository and components of a distributed electronic system (Schultz, engine 26-repository 22, Fig. 2; col. 2, line 57-col. 3, line 9), wherein the information repository comprises a scalable data model, wherein the service manager is adapted to log on to a directory and interacts therewith to create, delete, amend and/or search for information in the information repository (Schultz, col.3, lines 10-52;col.12, line 66-col.13, line 7; col.17, lines 17-34) and wherein the data model comprises domains, which domains comprise object types of users, services, profiles and infrastructure, such that a user is

assigned to a profile, which profile is adapted to access a plurality of services, which services run on infrastructure (Schultz, user, profiles, col.11, line 29-col.12, line 52; the repository stored the object keys for type of service such as news service or infrastructure, inherent that this includes domains name, col.4, lines 43-54;col.12, lines 17-21), and

wherein the data model comprises further objects, which further objects are configuration objects for intercommunicating between said object types of users, services, profiles and infrastructure, which configuration objects comprise a profile service configuration object, a user service configuration object and a service infrastructure configuration object, wherein a user service configuration object is adapted to configure use of the service when associated with a particular user, a profile service configuration object is adapted to configure aspects of the service when associated with a particular profile and service infrastructure configuration object is adapted to configure aspects of the service when associated with a particular piece of infrastructure (Schultz, col. 12, lines 20-50, Schultz disclosed the system determining which news entries the user wishes to see on his custom news page, based from the users customizable user profile).

15. Regarding claim 33, Schultz disclosed the limitations, substantially as claimed, as described in claim 32. Schultz did not explicitly state in which a user is assigned a plurality of profiles which profiles comprise a plurality of services. However, the mere duplication of parts has no patentable significance unless a new and unexpected result

is produced. See MPEP 2144.04 VI.(B). See also *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 21, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz et al. (U.S. 6,453,339).

17. Regarding claim 21, Schultz was applied for the claim rejection, cited in a previous Office Action, and still remains applicable to the claim.

18. Regarding claims 34 and 35, Schultz disclosed the limitations, substantially as claimed, as described in claims 32 and 33. Schultz did not explicitly state wherein the domain contains sub-domains.

Examiner takes Official Notice (see MPEP § 2144.03) that "domains including sub-domains" in a networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position".

However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or reputation of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight. See *Shuster et al.* (U.S. 6,687,746).

19. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz et al. (U.S. 6,453,339), as applied to claim 18, and in view of Ranalli et al. (U.S. 6,539,077).

20. Regarding claim 26, Schultz and Ranalli was applied for the claim rejection, cited in a previous Office Action, and still remain applicable to the claim.

Response to Amendment

Applicant's arguments submitted 21 September 2005 have been fully considered but are not persuasive.

21. Applicant argues that the "specification [includes] the function and interaction of the service manager with the other components of the system."

Applicant must show support for this by pointing to portions of the Specification that provide evidence. The term "service manager" will continue to be interpreted with its broadest reasonable interpretation (see Previous Office Actions) that is consistent with the disclosures of the specification and the interpretation that those skilled in the art would reach. See MPEP § 2111. See also *In re American Academy of Science Tech Center*, 2004 WL 1067528 (Fed. Cir. May 13, 2004) ("While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow") Further, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

22. Applicant argues, "claim 18 recites that the service manager interfaces with both an information repository and components of a distributed electronic system."

Examiner respectfully disagrees as explained in the above claim objection and 112 rejections. Examiner strongly suggests Applicant amend the claims in order to follow MPEP 608.01(m). Applicant is strongly advised to clarify the claim language by using semicolons and indentations to improve the claim readability. The claims

currently read as a run-on sentence in which it is hard to determine which limitations describe which elements.

23. Applicant simply states that "Both the specification and claims set forth the features of the service manager which are not disclosed in the prior art." Applicant does not make any reference towards the previously applied art or how the claimed invention is novel over the previously applied art, nor does Applicant make any reference towards any portion of the instant specification.

It is noted that the Applicant has made no attempt to show why each and every amendment made to the claims have any sort of patentable novelty or advantage.

MPEP 714.04 states:

"In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the claims should not be allowed. See 37 CFR 1.111 and MPEP 714.02."

Therefore, the case is not in condition for allowance.

24. Examiner attempted to contact Applicant on 04 December 2005, and left a message, however a response has not been received.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Business Center (EBC) at 866-217-9197 (toll-free).



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